

Application No.: 10/674,589
Office Action Dated 09/08/2004
Response Dated 12/08/2004

Atty. Docket No.: SK703.IPT1
Customer No.: 24943

REMARKS

I. STATUS OF CLAIMS

Claims 1-20 are pending in the application. Of these claims, claims 13-20 have been withdrawn from consideration as being drawn to a non-elected invention. In the above amendments, Claims 1, 2, 4, 5, 7-12 were amended, Claims 21-24 were added. No new matter is involved.

Claims 1, 2, 4, 5, and 8-11 are objected to due to informalities of the claim language.

Claim 12 is rejected under 35 U.S.C. §112 ("Section 112"), second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter of the invention.

Claims 1, 4, 5, 7, 9, and 11 are rejected under 35 U.S.C. §102(b) ("Section 102(b)") as being anticipated by Otake (JP2000-201545), (hereinafter referred to as "Otake").

Claims 2, 3, 6, 8, and 10 are rejected under 35 U.S.C. §103(a) ("Section 103(a)") as being unpatentable over Otake in view of DiMuzio (US 6,237,882), (hereinafter referred to as "DiMuzio"). Claim 12 is rejected under Section 103(a) as being unpatentable over Otake in view of Pierce (US 4,190,984), (hereinafter referred to as "Pierce").

Applicant respectfully traverses all rejections and requests reconsideration.

A. CLAIM OBJECTIONS

Claims 1, 2, 4, 5, and 8-11 are objected to due to informalities of the claim language. Claims 1, 2, 4, 5, and 8-11 have been amended to correct the informalities as identified by Examiner on pages 2-3 of the Office Action. Accordingly, Applicant respectfully requests withdrawal of the objections to claims 1, 2, 4, 5, and 8-11.

B. REJECTION UNDER SECTION 112, PAR. 2

Claim 12 has been amended to particularly point out and distinctly claim the subject matter of the invention. Claim 12 has been amended to provide proper antecedent basis for the cited limitation.

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Accordingly, Applicant respectfully requests withdrawal of the rejection of claim 12 under Section 112, second paragraph.

C. REJECTION UNDER SECTION 102(b), OTAKE

The Examiner rejected claim 1 under 35 U.S.C. §102 as being anticipated by Otake. Claim 1 has been amended and is no longer anticipated by Otake. Otake describes a sphagnum topiary structure having an opening for a hand to fit through with a door (Otake, Abstract, par. 0006). The opening described by Otake only allows the user to place one hand into the 3-D structure to place sphagnum into the structure. (See Fig. 2 and claim 1). Otake teaches that the opening allows one to use his hands to better "pack" and "stuff" sphagnum. (Otake, par. 0006). Applicant has explained this type of "sphagnum topiary" that "involves filling the frame with material" and requires one to wait for the plant to "mature and assume the shape of the topiary form" as a disadvantage to topiary making. (See Application page 5, line 19 and page 6, line 9). Hence, the teaching of Otake is precisely the problem that the present invention sets out to solve.

Claim 1, as amended, now recites a limitation that the topiary frame in its open position, "enable one or more of the two or more separable members to move upon a center axis and pivot or rotate along their one or more hinges such that the interior side of the main structure is completely exposed allowing for the main structure to enclose around a growing plant". Support for such amendment is found in Applicant's specification disclosing how the interior side of the structure is placed about the plant. (See Application, page 8, paragraph 0027, lines 11-18). Nowhere in Otake does the opening completely expose the interior side of the main structure, and neither does Otake allow for the main structure to enclose around a growing plant. In fact, Otake teaches away from such type of topiary structure of enclosing a growing plant in Applicant's amended claim 1, by teaching the use of the sphagnum technique with their structure where material is hand filled into the frame. The frame in Otake does not disclose having "the interior side of the main structure...completely exposed allowing for the main structure to enclose around a growing plant".

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Accordingly, Otake does not anticipate amended claim 1. For the above reasons, Applicant respectfully submits that amended claim 1 is patentable over Otake.

Claims 4, 5, 7, 9 and 11

Dependent claims 4, 5, 7, 9, and 11 include all limitations of their respective base claim 1, now amended. Accordingly, Applicant respectfully submits that these dependent claims are all allowable for the same reasons as is claim 1. Accordingly, Applicant respectfully submits that these dependent claims are all allowable for at least the same reasons as is amended claim 1. Furthermore, Applicant respectfully submits that these dependent claims are further allowable for the limitations that they themselves recite.

Applicant respectfully disagrees with the assertions regarding the dependent claims from the Office Action. The assertions have been made moot by the above discussion of the base claim.

For the above reasons, Applicant respectfully requests withdrawal of the rejection of Claims 4, 5, 7, 9 and 11 under Section 102(b).

D. REJECTION UNDER SECTION 103(a), OTAKE IN VIEW OF DIMUZIO

Claims 2, 3, 6, 8 and 10 were rejected under Section 103(a) as obvious over Otake in view of DiMuzio. Applicant respectfully traverses Examiner's rejection as explained below.

As explained in M.P.E.P. Section 706.02(j):

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

The three above-mentioned criteria must exist at the time the claimed invention was made, according to the text of Section 103(a) itself. The Examiner has not established a prima facie case of obviousness for at least the reasons stated below.

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Claims 2, 3 and 6 all depend from its base claim, independent amended claim 1. As amended, claim 1 requires the limitation that the topiary frame in its open position, "enable one or more of the two or more separable members to move upon a center axis and pivot or rotate along their one or more hinges such that the interior side of the main structure is completely exposed allowing for the main structure to enclose around a growing plant". Such limitation is nowhere provided by the combination of Otake with DiMuzio. As mentioned above, the deficiencies of Otake have been discussed in connection with amended claim 1. DiMuzio simply does not supply the deficiencies of Otake. Accordingly, Applicant respectfully submits that claims 2, 3 and 6 are allowable for at least the same reasons as is amended claim 1.

In rejecting claim 8, the Examiner cites to element 20 from Figure 14 of DiMuzio. (See Fig. 14 and col. 4 lines 11-21). Element 20 of DiMuzio is described as "corkscrew shaped pins." (See col. 4 lines 6-7). An actual fruit, vegetable, or candles can be mounted to the threaded corkscrew. (See col. 4 lines 11-21). However, Applicant recites in amended claim 8, which depends from the limitations of amended claim 7 that the "objects" corresponding to the "upper and lower extremity set of members" are "for enclosing topiary foliage" and having a "three-dimensional unitary form". Thus, while DiMuzio describes having actual fruits attached to the topiary, these fruits are not part of any "three-dimensional unity form" of the "topiary frame"; in fact, the cited element 20 is a pin, which is in no manner "for enclosing topiary foliage". As such, DiMuzio does not disclose a topiary frame comprising objects "for enclosing topiary foliage" but rather teaches that actual fruits, which are not part of the frame, are attached independently to "pins" on the frame.

In addition, claim 8 further incorporates the base limitations of amended claim 1, and as mentioned, DiMuzio does not supply the deficiencies of Otake. Accordingly, Applicant respectfully requests that amended claim 8 is allowable for at least the same reasons as is amended claim 1.

In rejecting claim 10, the Examiner stated that the limitations of claim 8 are disclosed by DiMuzio and that a

"bear design with fruit etc. was an art-recognized equivalent to a seal and ball in animal-from topiaries where in is immaterial as the exact animal form, it would have

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been obvious to one of ordinary skill in the art at the time the invention to substitute the bear/fruit with the seal/ball in the topiary of Otake as modified by DiMuzio." (Office Action, page 6).

However, Applicant disagrees with the Examiner's assertion, because no where is there any suggestion of a bear with fruit, especially because as discussed above, the fruit of DiMuzio is actual fruit mounted to protrusions, threaded corkscrews, and in no manner a part of the three-dimensional unitary form of the topiary frame for "enclosing topiary foliage" as required in claim 10. Furthermore, neither does DiMuzio provide for all the claim limitations of claim 10, as it is ultimately dependent upon the limitations of amended claim 1, which are deficient in Otake as discussed above.

Accordingly, Otake in view of DiMuzio fail to teach or suggest ALL claim limitations as required to establish a *prima facie* case of obviousness. Accordingly, Applicant respectfully requests withdrawal of the rejections of Claims 2, 3, 6, 8 and 10 under Section 103(a).

E. REJECTION UNDER SECTION 103(a), OTAKE IN VIEW OF PIERCE

Claim 12 depends on and includes all limitations of its respective base claim 1. The deficiencies of Otake have been discussed above in connection with amended claim 1. Pierce simply does not supply the deficiencies of Otake, in particular, at least the limitation of the topiary frame in its open position, "enable one or more of the two or more separable members to move upon a center axis and pivot or rotate along their one or more hinges such that the interior side of the main structure is completely exposed allowing for the main structure to enclose around a growing plant". Accordingly, Applicant respectfully submits that claim 12 is allowable for at least the same reasons as is amended claim 1 and requests withdrawal of the rejection of claim 12 under Section 103(a).

F. NEW CLAIMS 21-24

New claims 21-24 have been added to claim the invention more extensively without adding new matter. Applicant respectfully submits that the new claims are allowable over the cited at least for reasons similar to those by which amended claim 1 is allowable over the cited art. Otake, DiMuzio and Pierce are dedicated to their achieving their own respective

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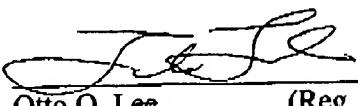
claims, as discussed above, and simply do not teach or even suggest the elements of the new claims 21-24. Accordingly, Applicant respectfully submits that new claims 21-24 are allowable.

II. CONCLUSION

The above-discussed amendments and remarks are believed to place the present Application in condition for allowance. Should the Examiner have any questions regarding the above amendments, the Examiner is requested to telephone Applicant's representative at the number listed below.

Respectfully submitted,

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